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09/391,285 09/07/99 KING

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TM02/0716

EXAMINER

NGUYEN, N

ART UNIT

PAPER NUMBER

2164

DATE MAILED:

07/16/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/391,285

Applicant(s)  
King

Examiner  
Nguyen Nga B

Art Unit  
2164



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 5, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26, 28, and 31 is/are rejected.
- 7) ☒ Claim(s) 27, 29, 30, and 32-36 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. This Office Action is the answer to the Amendment filed on April 5, 2001 , which paper has been placed of record in the file.
2. Claims 27-36 are added. Claims 1-36 are pending in this application.

#### *Response to Arguments/Amendment*

3. Applicant's arguments with respect to claims 1-26 have been fully considered but are moot in view of the new ground(s) of rejection.
4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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*Allowable Subject Matter*

5. Claims 27, 29, 30, and 32 are objected to as being dependent upon the rejected base claims 1, 9, 17, and 22, respectively, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 33-36 are objected to because of the incorrected terms in the claimed language (see below), but would be allowable if rewritten including all the following correction:

In claim 33: line 4, replace “first number” by “ATM card number”.

lines 4 and 12, insert “merchant’s” before “web site”.

lines 6 and 8, insert “on said consumer’s computer” after “web browser”.

line 10, replace “first and second numbers” by “ATM card number and said PIN”.

In claim 34: line 3, replace “merchant” to “merchant’s”.

lines 6 and 13, insert “merchant’s” before “web site”.

line 7, insert “associated with ATM card number” after “PIN”.

In claim 35: line 11, insert “merchant’s” before “web site”.

In claim 36: line 8, insert “merchant’s” before “web site”.

*Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 1, 2, 4-10, 12-26, 28, and 31 are rejected under 35 U.S.C. 102(a) as being anticipated by Sixtus, U.S. Patent No. 5,903,721.

Regarding to claim 1, Sixtus discloses a method for making purchases over a computer network using a first number that identifies a consumer's account from which funds will be withdrawn to pay a purchase price and a second number associated with first number which, when used with first number, enable withdrawal of funds from account, method comprising the steps of:

transmitting first number over network from a consumer location to an on-line merchant location (column 9, lines 22-27);

forwarding first number over network from on-line merchant location to a third party contractor location (column 9, lines 54-62);

transmitting a query for second number over network from third party contractor location to consumer location (column 10, lines 52-60);

transmitting second number over network from consumer location to third party contractor location (column 10, lines 55-58); and

checking at third party contractor location whether first and second numbers are valid (column 10, lines 16-23 and 58-60).

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Regarding to claim 2, Sixtus further discloses on-line merchant location is bypassed second number when second number is transmitted from consumer location to third party contractor location (column 10, lines 52-60).

Regarding to claim 4, Sixtus further discloses network is the Internet (figure 1, item 16).

Regarding to claim 5, Sixtus further discloses checking at third party contractor location whether account has sufficient funds to cover purchase price (column 7, lines 1-10).

Regarding to claim 6, Sixtus further discloses transmitting a signal from third party contractor location to on-line merchant location indicating whether first and second numbers are valid (column 10, line 60-column 11, line 3).

Regarding to claim 7, Sixtus further discloses transmitting a signal from third party contractor location to on-line merchant location indicating whether there are sufficient funds in account to cover purchase price (column 7, line 1-8).

Regarding to claim 8, Sixtus further discloses transmitting a signal from on-line merchant location to consumer location indicating whether purchase has been authorized (column 10, line 65-column 11, line 3).

Regarding to claim 28, Sixtus further discloses consumer location is a consumer computer, on-line merchant location is an on-line merchant computer, and third party contractor location is a third party contractor computer (see figure 1).

Regarding to claim 9, Sixtus discloses a system for making purchases over a computer network using a first number that identifies a consumer's account from which funds will be

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withdrawn to pay a purchase price and a second number associated with first number which, when used with first number, enable withdrawal of funds from account, system comprising:

a first computer at a consumer location, first computer being connected to network (figure 1, item 12);

a second computer at an on-line merchant location, second computer being connected to network (figure 1, item 14); and

a third computer at a third party contractor location, third computer being connected to network (figure 1, item 18);

wherein first number is transmitted from first computer to second computer over network (column 9, lines 22-27);

wherein first number is forwarded from second computer to third computer over network (column 9, lines 54-62);

wherein a query for second number is transmitted from third computer to first computer over network (column 10, lines 52-60);

wherein second number is transmitted from first computer to third computer over network (column 10, lines 52-60);

wherein third computer checks whether first and second numbers are valid column 10, lines 16-23 and 58-60).

Regarding to claim 10, Sixtus further discloses first computer bypassed second computer when transmitting second number to third computer (column 10, lines 52-60).

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Regarding to claim 12, Sixtus further discloses network is the Internet (figure 1, item 16).

Regarding to claim 13, Sixtus further discloses third computer checks whether account has sufficient funds to cover purchase price (column 7, lines 1-10).

Regarding to claim 14, Sixtus further discloses third computer notifies second computer whether first and second numbers are valid (column 10, line 60-column 11, line 3).

Regarding to claim 15, Sixtus further discloses third computer notifies second computer whether there sufficient funds in account to cover purchase price (column 7, line 1-8).

Regarding to claim 16, Sixtus further discloses second computer notifies first computer whether purchase is authorized (column 10, line 65-column 11, line 3).

Regarding to claim 17, Sixtus discloses a method of authorizing a purchase to be made over a computer network using a first number that identifies a consumer's account from which funds will be withdrawn to pay a purchase price and a second number associated with first number which, when used with first number, enable withdrawal of funds from account, method comprising the steps of:

receiving at a third party contractor location first number transmitted over network from an on-line merchant location (column 9, lines 54-62);

transmitting a query for second number over network from third party contractor location to a consumer location (column 10, lines 52-60);

receiving at third party contractor location second number transmitted over network from a consumer location (column 10, lines 52-60);



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verifying the validity of first and second numbers at third party contractor location column 10, lines 16-23 and 58-60).

Regarding claim 18, Sixtus further discloses network is the Internet (figure 1, item 16).

Regarding claim 19, Sixtus further discloses checking at third party contractor location whether account has sufficient funds to cover purchase price (column 7, lines 1-10).

Regarding claim 20, Sixtus further discloses transmitting a signal from third party contractor location to on-line merchant location indicating whether first and second numbers are valid (column 10, line 60-column 11, line 3).

Regarding claim 21, Sixtus further discloses transmitting a signal from third party contractor location to on-line merchant location indicating whether there are sufficient funds in account to cover purchase price (column 7, line 1-8).

Regarding to claim 31, Sixtus further discloses consumer location is a consumer computer, on-line merchant location is an on-line merchant computer, and third party contractor location is a third party contractor computer (see figure 1).

Claims 22-26 are system claims that parallel limitations found in claims 17-21, respectively, therefore are rejected by the same rationale.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sixtus, U.S. Patent No. 5,903,721 in view of Official notice taken by Examiner.

Regarding to claim 3, Sixtus does not teach first and second numbers are transmitted over network via encrypted connections. Official notice is taken that transmitting first and second numbers over network via encrypted connections is old and well-known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include encrypted technique when transmitting first and second numbers in Sixtus's for the purpose of providing more security.

Claim 11 contains similar limitations as found in claim 3, therefore is rejected by the same rationale.

### ***Conclusion***

11. Claims **1-26, 28, and 31** are rejected.

Claims **27, 29, 30, and 32-36** are objected to.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen, whose telephone number is (703)306-2901. The examiner can normally be reached on Monday-Thursday from 7:30 AM-5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A. Millin, can be reached on (703)308-1065.

**13. Any response to this action should be mail to:**

Commissioner of Patents and Trademarks  
c/o Technology Center 2700  
Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications intended for entry)

**or:**

(703) 308-5397 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II,  
2121 Crystal Drive, Arlington.  
VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)305-3900.

Nga B. Nguyen  
July 10, 2001

  
**VINCENT MILLIN**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**